

REMARKS

I. Introductory Comments

Applicants thank the Examiner for accepting the drawings filed on January 02, 2002. Claims 1-31 are currently pending. Claims 1, 9, 17, and 24 are independent claims. In the Office Action, claims 1, 4, 9, 12, 17-19, 24, and 27 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Applicants' Background of the Invention, U.S. Patent Application Publication No. 20020138416 ("Applicants' Background"), in combination with the Official Notice taken by the Examiner. Claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25, 26, and 28-31 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Applicants' Background in combination with U.S. Patent Application Publication No. 20020091699 ("Norton").

Claims 6, 7, 14, 15, 21, 22, 29, and 30 have been amended to fix a typographical error. No substantive amendments have been made in the present paper. For at least the reasons set forth below, all pending claims are believed to be in condition for allowance. All claim rejections are believed to be addressed herein. Therefore, this response is believed to be a complete response to the Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims in future papers, including the separate patentability of the dependent claims not explicitly addressed herein.

II. Official Notice

In the Office Action, the Examiner took Official Notice. Applicants expressly do not acquiesce to the taking of Official Notice. Therefore, Applicants respectfully request that the Examiner provide an affidavit in the next Office Action to support the Official Notice taken, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

III. Argument

A. Claim Rejections – 35 U.S.C. §103(a)

The basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness are as follows:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations.
(MPEP § 2143, emphasis added.)

B. Independent Claims 1, 9, 17, and 24 Are Patentable Over Applicants' Background And The Examiner's Official Notice

The Examiner asserted that independent claims 1, 9, 17, and 24 are obvious and therefore unpatentable over Applicants' Background, combined with the Official Notice taken by the Examiner. However, Applicants' Background is merely background information, and does not teach or suggest numerous recitations found in Applicants' claims, as discussed in detail below.

1. "inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed"

Independent claims 1, 9, 17, and 24 each recite in part "inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed." The Examiner alleged that the "Inventory and definition" section of Applicants' Background teaches this recitation. (Office Action, page 2.) However, Applicants' Background says nothing at all about "a location asset type [that] includes physical locations where the electronic asset types are placed." Therefore, Applicants' Background fails to teach or suggest at least this recitation of independent claims 1, 9, 17, and 24.

At most, Applicants' Background suggests that an "organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes." (Applicants' Background: page 4, lines 11-13.) Applicants' Background states that there are "a number of conventional automated tools [that] can assist the organization in accomplishing this phase of the process." (Applicants' Background: page 4, lines 17-18.) However, Applicants' Background says nothing at all about a location asset type that includes the physical location of an electronic asset. Also, Applicants' Background doesn't teach or suggest that each asset is defined to be one of an electronic asset type and a location asset type.

Because Applicants' Background fails to teach or suggest "inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the

electronic asset types are placed,” the rejections of claims 1, 9, 17, and 24, and the claims that depend therefrom, should be withdrawn.

2. “identifying at least one criterion defining a security objective of the organization”

Independent claims 1, 9, 17, and 24 further recite in part “identifying at least one criterion defining a security objective of the organization.” The Examiner alleged that the “Vulnerability and threat evaluation” section of Applicants’ Background teaches this recitation. (Office Action, page 3.) However, Applicants’ Background not only fails to teach or suggest at least this recitation of claims 1, 9, 17, and 24, but Applicants’ Background also teaches away from identifying at least one criterion defining a security objective of the organization.

At most, Applicants’ Background teaches that there are many criteria and sets of criteria available to use for vulnerability and threat evaluation. For example, auditors can use any of the following sets of criteria: Common Criteria from Decisive Analytics; Orange Book from the U.S. Department of Defense; COBIT from the Information Systems Audit and Control Foundation; and SAS 70 from the U.S. Security and Exchange Commission. (Applicants’ Background: page 4, lines 17-23.) Each set of criteria contains many criteria available for use.

However, Applicants’ Background says nothing at all about identifying a criterion defining a security objective of the organization, but merely that there are many criteria, and sets of criteria available to use for vulnerability and threat evaluation. Further, Applicants’ Background states that “[v]ulnerability and threat assessment is typically performed by an internal audit department or third party auditor using a set of assessment criteria.” (Applicants’ Background: page 5, lines 4-6.) So, Applicants’ Background teaches using a pre-defined set of criteria, as opposed to identifying at least one criterion defining a security objective of the organization. Therefore, Applicants’ Background actually teaches away from “identifying at least one criterion defining a security objective of the organization.”

Because Applicants’ Background not only fails to teach or suggest “identifying at least one criterion defining a security objective of the organization,” but also teaches away from this recitation, the rejections of claims 1, 9, 17, and 24, and the claims that depend therefrom, should be withdrawn.

3. “identifying one or more inventoried assets that relate to the identified criterion”

Independent claims 1, 9, 17, and 24 further recite in part “identifying one or more inventoried assets that relate to the identified criterion.” The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches this recitation. (Office Action, page 4.) However, Applicants’ Background says nothing at all about “identifying one or more inventoried assets that relate to the identified criterion.” Therefore, Applicants’ Background also fails to teach or suggest at least this recitation of claims 1, 9, 17, and 24. Further, Applicants’ Background actually teaches away from identifying one or more inventoried assets that relate to the identified criterion.

Applicants’ Background says nothing at all about “identifying one or more inventoried assets that relate to the identified criterion.” The Examiner relied on the statement that “[o]nce assets have been identified, a value is assigned to each asset.” (Applicants’ Background: page 4, lines 13-14.) At most, Applicants’ Background suggests assigning a value to a previously identified asset. As stated in Applicants’ Background, “[t]his value is not only monetary, but also may be tied to loss of reputation or loss of trust.” (Applicants’ Background: page 4, lines 14-15.) This section says nothing at all about identifying an asset that relates to the identified criterion. At most, Applicants’ Background suggests that a value can be assigned to previously identified assets.

Further, Applicants’ Background teaches away from “identifying one or more inventoried assets that relate to the identified criterion.” Applicants’ Background states that “the organization determines its assets . . . [then] a value is assigned to each asset.” (Applicants’ Background: page 4, lines 11-14.) To examine the organization for weaknesses that could be exploited by an unauthorized outsider, a vulnerability and thread assessment is performed by an auditor. The auditor uses a set of assessment criteria to evaluate if vulnerabilities exist. (Applicants’ Background: page 5, lines 1-9.) Applicants’ Background teaches to perform an inventory of assets, and then evaluate those assets using a set of criteria. Such a teaching is contrary to “identifying one or more inventoried assets that relate to the identified criterion.” Therefore, if Applicants’ Background is at all relevant, it actually teaches away from “identifying one or more inventoried assets that relate to the identified criterion.”

Because Applicants' Background not only fails to teach or suggest "identifying one or more inventoried assets that relate to the identified criterion," but also teaches away from this recitation, the rejections of claims 1, 9, 17, and 24, and the claims that depend therefrom, should be withdrawn.

4. "assessing the risk to the organization based on the measured values of the one or more metric equations"

Independent claims 1, 9, 17, and 24 further recite in part "assessing the risk to the organization based on the measured values of the one or more metric equations." The Examiner alleged that Applicants' Background teaches this recitation, and relied on the statement that "[o]nce risk has been assessed and identified, the organization can choose to accept the risk, mitigate the risk, or transfer the risk." (Office Action, page 4.) However, Applicants' Background also fails to teach or suggest at least this recitation of claims 1, 9, 17, and 24.

At most, Applicants' Background suggests that once a risk has been assessed, an organization can make a decision as to whether to accept, mitigate, or transfer the risk. Applicants' Background says nothing at all about "assessing the risk to the organization based on the measured values of one or more metric equations." In fact, Applicants' Background does not in any way suggest use of metric equations at all, much less "measured values of the one or more metric equations."

Because Applicants' Background fails to teach or suggest "assessing the risk to the organization based on the measured values of the one or more metric equations," the rejections of claims 1, 9, 17, and 24, and the claims that depend therefrom, should be withdrawn.

5. "formulating one or more metric equations for each identified criterion"

Independent claims 1, 9, 17, and 24 further recite in part "formulating one or more metric equations for each identified criterion." The Examiner stated that Applicants' Background fails to teach or suggest this recitation of claims 1, 9, 17, and 24. (Office Action, page 3.) The Examiner then took Official Notice that "it is old and well-known in the business and scientific world to set up metric equations for measured variables, wherein this statement of equality between two expressions consisting of variable and/or numbers is used to answer business organizational questions in a systematic way." (Office Action, page 3.)

However, Applicants expressly do not acquiesce to the taking of Official Notice. Therefore, Applicants respectfully request that the Examiner provide an affidavit in the next Office Action to support the Official Notice taken, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03. Because Applicants' Background fails to teach or suggest "formulating one or more metric equations for each identified criterion," and the Examiner's Official Notice is improper, the rejections of claims 1, 9, 17, and 24, and the claims that depend therefrom, should be withdrawn.

C. Dependent Claims 4, 12, 19, and 27 Are Patentable Over Applicants' Background And The Examiner's Official Notice

1. "wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users"

Dependent claims 4, 12, 19, and 27 further recite in part "wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users." The Examiner alleged that the "Inventory and definition" section of Applicants' Background teaches this recitation. (Office Action, page 4.) However, Applicants' Background says nothing at all about "the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users." Therefore, Applicants' Background fails to teach or suggest at least this recitation of dependent claims 4, 12, 19, and 27.

At most, Applicants' Background suggests that an "organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes." (Applicants' Background: page 4, lines 11-13.). Applicants' Background says nothing at all about "the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group

of users.” In fact, Applicants’ Background makes no mention of “a user type, a user population type, a data type, [or] a network type.”

Because Applicants’ Background fails to teach or suggest “wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users,” the rejections of claims 4, 12, 19, and 27, and the claims that depend therefrom, should be withdrawn.

D. The Examiner’s Failure To Make A Prima Facie Obviousness Rejection Of Dependent Claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25, 26, and 28-31

1. “formulating one or more metric equations for each identified criterion”

Claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25, 26, and 28-31 are all dependent claims, and each claim depends from an independent claim that recites in part “formulating one or more metric equations for each identified criterion.” Because these claims are dependent, they each necessarily incorporate all of the recitations of the independent claim from which they depend. As such, claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25, 26, and 28-31 each necessarily incorporates “formulating one or more metric equations for each identified criterion.”

The Examiner alleged that these dependent claims were unpatentable over Applicants’ Background in combination Norton. (Office Action, page 4.) However, the Examiner failed to make a prima facie obviousness rejection by failing to account for this recitation found in the independent claims. The Examiner conceded that Applicants’ Background fails to teach or suggest this recitation of claims 1, 9, 17, and 24. (Office Action, page 3.) Norton also fails to teach or suggest this recitation of claims 1, 9, 17, and 24.

Therefore, the Examiner has failed to establish a prima facie case of obviousness against claims 2, 3, 5-8, 10, 11, 13-16, 20-23, 25, 26, and 28-31. Although the Examiner failed to establish a prima facie obviousness rejection, Applicants nonetheless traversed these rejections in order to further prosecution.

E. Dependent Claims 5, 13, 20, and 28 Are Patentable Over Applicants' Background In Combination With Norton

1. "establishing at least one relationship between the plurality of assets"

Dependent claims 5, 13, 20, and 28 further recite in part "establishing at least one relationship between the plurality of assets." The Examiner stated that Applicants' Background does not explicitly disclose this recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants' Background. (Office Action, page 5.) However, Norton says nothing at all about "establishing at least one relationship between the plurality of assets." Therefore, Norton fails to teach or suggest at least this recitation of dependent claims 5, 13, 20, and 28.

The Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Office Action, page 5.) At most, Norton discloses a variety of "asset search options" that "enables a user not only to search for an asset, but also to view a range of detailed information about the selected asset." (Norton: page 4, ¶¶ 85-87.) Norton further discloses that "The Asset tab 70 displays detailed asset information for the asset selected," and that such information may include the asset's serial number, tracking number, purchase order, manufacturer, model number, etc. (Norton: pages 4-5, ¶¶ 88-93.)

Norton not only fails to disclose "establishing at least one relationship between the plurality of assets," but actually makes no mention of this recitation at all. Because Norton fails to teach or suggest "establishing at least one relationship between the plurality of assets," the rejections of claims 5, 13, 20, and 28, and the claims that depend therefrom, should be withdrawn.

F. Dependent Claims 6, 14, 21, And 29 Are Patentable Over Applicants' Background In Combination With The Examiner's Official Notice And Norton

1. "linking a first asset defined to be in one asset type with a second asset defined to be in another asset type"

Dependent claims 6, 14, 21, and 29, as amended, further recite in part "linking a first asset defined to be in one asset type with a second asset defined to be in another asset type." The Examiner stated that Applicants' Background does not explicitly disclose this recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants' Background. (Office Action, page 5.) However, Norton says nothing at all about "linking a first asset defined

to be in one asset type with a second asset defined to be in another asset type.” Therefore, Norton fails to teach or suggest at least this recitation of dependent claims 6, 14, 21, and 29.

Again, the Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Office Action, page 5.) At most, Norton discloses a variety of “asset search options” that allow a user to search for an asset, and view detailed information about a selected asset. (Norton: page 4, ¶¶ 85-87.)

Norton fails to disclose “linking a first asset defined to be in one asset type with a second asset defined to be in another asset type,” and actually makes no mention of this recitation at all. Because Norton fails to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in another asset type,” the rejections of claims 6, 14, 21, and 29, and the claims that depend therefrom, should be withdrawn.

**G. Dependent Claims 7, 15, 22, And 30 Are Patentable Over Applicants’
Background In Combination With The Examiner’s Official Notice And Norton**

**1. “linking a first asset defined to be in one asset type with a second
asset defined to be in the same asset type”**

Dependent claims 7, 14, 22, and 30, as amended, further recite in part “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type.” The Examiner stated that Applicants’ Background does not explicitly disclose this recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants’ Background. (Office Action, page 5.) However, Norton says nothing at all about “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type.” Therefore, Norton fails to teach or suggest at least this recitation of dependent claims 6, 14, 21, and 29.

Again, the Examiner alleged that Norton teaches this recitation on page 4, ¶¶ 85-90. (Office Action, page 5.) At most, Norton discloses a variety of “asset search options” that allow a user to search for an asset, and view detailed information about a selected asset. (Norton: page 4, ¶¶ 85-87.)

Norton fails to disclose “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type,” and actually makes no mention of this recitation at all. Because Norton fails to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in the same asset type,” the rejections of claims 7, 15, 22, and 30, and the claims that depend therefrom, should be withdrawn.

CONCLUSION

In view of the above, all claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0525. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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